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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHUNG, JASON J

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 09/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/257,209

Applicant(s)

OCHIAI, KATSUHIRO

Examiner

Jason J. Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,28,29 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,28,29 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/13/03 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-10, 28-29, and 35-38 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendment. The examiner takes the prior read of Iwamura in view of Van Steenbrugge and takes a different read of the combination of references as necessitated by amendment. Additionally, the examiner applies more art to provide a separate rejection of all the pending claims as necessitated by amendment.

III. AUTOMATING A MANUAL ACTIVITY

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an

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automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Claim Objections

3. Claims 1, 3, 7, 9 objected to because of the following informalities: there is no antecedence for the recitation of the first stating of "the state" in each of the claims. The examiner interprets each claim to state, "a state". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 28-29, 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Ito (US Patent # 6,085,019).

Regarding claim 1, Ito discloses a control bus 20 and a data bus 22 (column 5, lines 45-61); the combination of the data bus and control bus reads on a network.

Ito discloses a recording/reproducing control circuit 34 (column 5, lines 45-61), which meets the limitation on a network management apparatus for managing the network.

Ito discloses a recording/reproducing device 26, data I/O devices 10 (column 5, lines 45-61). Ito discloses the external devices 2 (column 6, lines 13-24); the recording reproducing

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device 26, data I/O devices, and external devices 2 read on plural types of video apparatuses connected to the network.

The examiner notes the claim is worded in such a way where **only one of** the following limitations must be met: function, application program interfaces, service-availability, stored programs. Ito discloses the recording/reproducing control circuit 34 identifies an address of the record medium at which new video data may be recorded (column 7, lines 25-37), which meets the limitation on application program interface. Ito discloses the recording/reproducing control circuit 34 (network management apparatus) searches for an empty or available recording region (column 7, lines 25-37), which meets the limitation on service availability and stored programs. Ito discloses when it is desired to record a signal on the recording/reproducing device 26, an external device supplies a record request signal to the recording/reproducing control circuit 34 (network management apparatus) (column 7, lines 15-25). Ito discloses the recording/reproduction device 26 sends the reproduction request signal to the recording/reproducing control circuit 34 via I/O device (column 8, lines 10-28), which meets the limitation on transmitting the function. Ito discloses the recording/reproducing control circuit has a memory, which contains an index or table of content (column 7, lines 31-37), which meets the limitation on network management apparatus stores the states of the plural types of apparatuses. Ito discloses during recording or reproducing, recording/reproducing control circuit 34 interfaces the recording/reproducing device to send signals to the external device (column 6, line 65-column 7, line 14), which meets the limitation on each of the plural types of video apparatuses to the network management apparatus and then determines based on information

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received without user input a video apparatus to be a communication partner on the states of other video apparatuses obtained from the network management apparatus.

Regarding claim 2, as disclosed in claim 1 rejection, there are a plurality of I/O devices 10 and a plurality of external devices, which meets the limitation on apparatuses of the same type connected to the network.

Regarding claim 3, the limitations in claim 3 have been met in claim 1 rejection.

Regarding claim 4, the limitations in claim 4 have been met in claim 2 rejection.

Regarding claim 5, the limitations in claim 5 have been met in claim 1 rejection.

Regarding claim 6, the limitations in claim 6 have been met in claim 2 rejection.

Regarding claim 7, the limitations in claim 7 have been met in claim 1 rejection.

Regarding claim 8, the limitations in claim 8 have been met in claim 2 rejection.

Regarding claim 9, the limitations in claim 9 have been met in claim 1 rejection.

Regarding claim 10, the limitations in claim 10 have been met in claim 2 rejection.

Regarding claim 28, the limitations in claim 28 have been met in claim 1 rejection.

Regarding claim 29, the limitations in claim 29 have been met in claim 1 rejection.

Regarding claims 35-36, Ito discloses the recording reproducing control apparatus searches for an empty or available recording region (column 7, lines 15-31), which meets the limitation on the communication partner is automatically selected by one of the video apparatuses concerning currently available resources and the video apparatuses do not include resources that are currently assigned to any video apparatuses.

Regarding claims 37-38, the limitations in claims 37-38 have been met in claims 35-36 rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura (US Patent # 5,883,621) in view of Van Steenbrugge (US Patent # 5,054,022).

Regarding claim 1, Iwamura discloses an IEEE 1394 serial bus standard (column 2, lines 5-7), which meets the limitation on network.

Iwamura discloses an IRD (network management apparatus) comprises of PHY 224 that initializes the bus (column 4, lines 55-67), which meets the limitation on a network management apparatus.

Iwamura discloses a DVD player 900, mini disc player 902, and digital VCRs 903, 904 (figure 10), which meets the limitation on plural types of video apparatuses connected to the network. Iwamura discloses a topology map that can be generated by a receiver or by a TV set (column 3, lines 24-29), which is the network management apparatus connected to a network.

The examiner notes the claim is worded in such a way where **only one of** the following limitations must be met: function, application program interfaces, service-availability, stored programs. Iwamura discloses the self identification process is performed with the DSS IRD 100 and the devices are given nodes and automatically assigned device names and the DSS IRD constructs a map in the CPU 312 of IRD (column 5, line 45-column 6, line 5), which meets the

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limitation on the plural types of video apparatus transmit the state relating to the application program interface. Iwamura discloses the user uses a drag and drop method for recording and figure 12 illustrates the signal flow information (column 8, lines 57-65), which meets the limitation on inquiring about the state of other video apparatuses and determining a communication partner based on information of the states of other video apparatuses which are obtained from the network management apparatus.

Iwamura fails to disclose the operation is performed without user input or automatically. Van Steenbrugge discloses automatic (without any user input) priority system for signal paths so that the user is not unnecessarily troubled with decision-making on signal paths to established and signal paths to be canceled (column 2, lines 15-28). Van Steenbrugge discloses videocassette recorders 42, 44, compact disc video players 46,58, video monitors 54, 56, TV apparatus 42; each of the devices has a control device (column 4, lines 60-68 and column 5, lines 1-9). Van Steenbrugge discloses the control devices are attached to a single path control bus 60 (column 5, lines 10-18; figure 2). Van Steenbrugge discloses the signal interconnection commands Connect and Select are used which may be connected to another switchbox subdevice or it may be connected via one or more switchboxes in between (column 6, lines 63-68 and column 7, lines 1-8). Van Steenbrugge discloses the connected to switchbox request and connected to switchbox request investigates (a video apparatus to be a communication partner) the other subdevice and plug on the subdevice it has current signal interconnections (on the basis of other states) (column 7, lines 35-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iwamura to have communication without

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user input as taught by Van Steenbrugge in order to give the user less unnecessary trouble with decision making on signal paths.

Regarding claim 2, Iwamura discloses a plurality of the same digital VCR's 903, 904 connected to a network (figure 10).

Regarding claim 3, the limitations in claim 3 have been met in claim 1 rejection.

Regarding claim 4, the limitations in claim 4 have been met in claim 2 rejection.

Regarding claim 5, the limitations in claim 5 have been met in claim 1 rejection.

Regarding claim 6, the limitations in claim 6 have been met in claim 2 rejection.

Regarding claim 7, the limitations in claim 7 have been met in claim 1 rejection.

Regarding claim 8, the limitations in claim 8 have been met in claim 2 rejection.

Regarding claim 9, the limitations in claim 9 have been met in claim 1 rejection.

Regarding claim 10, the limitations in claim 10 have been met in claim 2 rejection.

Regarding claim 28, the limitations in claim 28 have been met in claim 1 rejection.

Regarding claim 29, the limitations in claim 29 have been met in claim 1 rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

JJC


CHRIS GRANT
PRIMARY EXAMINER